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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,517	04/06/2000	Ralf Luche	200125.410	9043

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EXAMINER
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PATTERSON, CHARLES L JR

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 05/21/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/544,517

Applicant(s)

LUCHE ET AL.

Examiner

Charles L. Patterson, Jr.

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*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply****A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 12/26/00, 12/31/01 and 3/15/02.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 1,15-21 and 26-49 is/are withdrawn from consideration.
- 5) Claim(s) 11 is/are allowed.
- 6) Claim(s) 2-6,14 and 22-24 is/are rejected.
- 7) Claim(s) 7-10,12,13 and 25 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

Applicant's election without traverse of Group II, claims 2-14 and 22-25 in Paper No. 7 is acknowledged.

Claims 1, 15-21 and 26-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

The disclosure is objected to because of the following informalities:

On page 12, lines 6-7, the recitation of "(SEQ ID NO:3), is encoded by nucleotide bases located at nucleotide positions 148 though 161 of SEQ ID NO:1" should apparently be "(SEQ ID NO:3), is amino acids 148 though 161 of SEQ ID NO:2", or something similar. Nucleotide residues 148-161 of SEQ ID NO:1 correspond to amino acid positions 49.3-53.7 and do not encode SEQ ID NO:3. Similarly the recitation on page 44, lines 25-26 of "[t]he active site domain for DSP-4 was localized to the region encoded by nucleotides beginning at position 148 of SEQ ID NO:1" is wrong.

Appropriate correction is required.

Claims 6, 14 and 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is confusing in that it refers to claim 1, which claim was not elected for prosecution.

Claims 14 and 22-24 are indefinite in the recitation of "DSP-4". Abbreviations should be avoided in patent claims. A recitation of "dual-specificity phosphatase 5 (DSP-5)" claim 14, the first claim in which the recitation appears, would overcome this rejection.

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Claim 22 is indefinite in the recitation of "an antisense polynucleotide according to claim 10 or claim 11". There is no antecedent basis for "antisense polynucleotide" in claim 11, which is drawn to a polynucleotide.

Claim 22 is confusing and apparently incorrect in the recitation of "method for detecting DSP-4 expression in a sample, comprising...detecting in the sample an amount of the DSP-4 polynucleotide that hybridizes to the antisense polynucleotide, and therefrom detecting DSP-4 expression in the sample". Expression is not the presence of a polynucleotide but rather the transcription and translation of a polynucleotide into protein.

*No* The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

These claims read on nucleic acid molecules that encode polypeptides from anything whatsoever having 10 or 15 consecutive amino acids of SEQ ID NO:2. The molecule could be from a completely unrelated gene as long as it met these characteristics. Applicants have not taught one of ordinary skill in the art how to make and/or use polynucleotides of this breadth.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by either of Marra, et al. (U or W). The instant references teach a polynucleotide that encodes at least ten consecutive amino acids of SEQ ID NO:2.

Claims 2 and 3 are rejected under 35 U.S.C. 102(a or b) as being anticipated by either of Hillier, et al. (V) or Strausberg (X). The instant references teach a polynucleotide that encodes at least fifteen consecutive amino acids of SEQ ID NO:2.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Marra, et al. (U or W), Hillier, et al. (V) or Strausberg (X). The references are characterized *supra*. It would have been obvious to place the polynucleotides into a vector and the vector into a host cell, absent unexpected results. The motivation would have been to study the protein produced by the polynucleotide.

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Claim 11 is allowed. Claims 7-10, 12-13 and 25 are objected to as being dependent upon a rejected base claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 703-308-1834. The examiner can normally be reached on Monday - Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Charles L. Patterson, Jr.  
Primary Examiner  
Art Unit 1652

Patterson  
May 20, 2002